

REMARKS

Claims 1-3, 5-13, and 15-19 are currently pending in the instant application. Applicant has amended claims 1, 11 and 12 and canceled claims 2 and 3.

§112

The Examiner has rejected claims 18 and 19 under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner alleges that the claims are indefinite because the terms "UL-94HB standards" and "UL-94VO standards" do not positively identify the source of the standards or the version relied upon and further that said standards are subject to modification with time.

Applicant respectfully disagrees. The specification of the instant application defines the testing method for both UL-94HB (See ¶¶0080 and 0085) and UL-94VO (See ¶¶0088-0090) and the required values to meet the standard for both UL-94HB (See ¶0086) and UL-94VO (See ¶¶0091-0096). "[P]atent law permits the patentee to choose to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term that could differ in scope from that which would be afforded by its ordinary meaning." *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001). Thus, as the claim terms are explicitly defined in the present application, whether or not such terms could have different meaning in another context, such as the meaning they might have in the future, is irrelevant. The terms are defined in the specification which positively identifies what is required to meet said standards and positively identifies the means for determining whether said standards have been met. Therefore, Applicant respectfully

submits that claims 18 and 19 meet the requirements of definiteness as set forth in 35 U.S.C 112 second paragraph.

Obviousness

The Examiner has rejected claims 1-3, 5-7, 10-13, 15, 18 and 19 as obvious under 35 U.S.C. §103(a) over U.S. Patent No. 6,107,378 ("the '378 patent") in view of U.S. Patent No. 6,512,174 ("the '174 patent") in further view of U.S. Patent No. 5,872,169 ("the '169 patent"). The Examiner asserts that the '378 patent teaches a polylactic acid biodegradable resin and a hydrolysis inhibitor and that the difference between the claimed invention and the '378 patent is the failure of the '378 patent to teach the addition of a flame retardant. The Examiner further asserts that the '174 patent teaches that flame retardants can be added to similar resins. The Examiner also asserts that the '169 patent teaches a process for making substantially pure magnesium hydroxide for use as a flame retardant for resin having a BET surface area of 0.9 to 3.5 m²/g. The Examiner assert that it would have been obvious for one of skill in the art to combine these references to arrive at the inventions claimed in claims 1-3, 5-7, 10-13, 15, and 18-19.

As amended, polyactic acid biodegradable resins are no longer claimed in claims 1-3, 5-7, 10-13, and 15 of the current application. Therefore, Applicant respectfully submits that these claims are not obvious in view of the cited art. With respect to claims 18 and 19, none of the cited art discloses any compositions which meet the claim limitations, namely, at least meeting the UL-94HB and UL-94VO standards respectively.

The Examiner has also asserted that, with respect to claim 15, only simple experimentation would have been required to arrive at the claimed ranges of hydroxide. Applicant submits that this rejection has been rendered moot in light of the amendment to claim 1.

The Examiner has also rejected claims 8, 9 and 16 under 35 U.S.C. §103(a) as obvious over the '378 patent in view of the '174 patent and in further view of U.S. Patent No. 6,720,365 ("the '365 patent"). The Examiner asserts that the '378 patent teaches a polylactic acid biodegradable resin and a hydrolysis inhibitor; that the '174 patent teaches the use of flame retardants with similar resins; and that the '365 patent teaches the use of phosphorous compounds in making flame retardant compositions using similar resins. The Examiner assert that it would have been obvious for one of skill in the art to combine these references to arrive at the inventions claimed in claims 8, 9, and 16.

As amended, polyactic acid biodegradable resins are no longer claimed in claims 8, 9, and 16 of the current application. Therefore, Applicant respectfully submits that these claims are not obvious in view of the cited art.

The Examining has also rejected claims 8, 9 and 17 under 35 U.S.C. §103(a) as obvious over the '378 patent in view of the '174 patent and in further view of U.S. Application No. 2001/0018487 ("the '487 application"). The Examiner asserts that the '378 patent teaches a polylactic acid biodegradable resin and a hydrolysis inhibitor; that the '174 patent teaches the use of flame retardants with similar resins; and that the '487 application teaches the use of 4-50 micron silica in making flame retardant resin compositions.

As amended, polyactic acid biodegradable resins are no longer claimed in claims 8, 9, and 17 of the current application. Therefore, Applicant respectfully submits that these claims are not obvious in view of the cited art.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 

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